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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,081	08/06/2003	Pramod K. Gupta	24866A	9824
28624 7590 06/30/2008 WEYERHAEUSER COMPANY INTELLECTUAL PROPERTY DEPT., CH 1J27 P.O. BOX 9777 FEDERAL WAY, WA 98063				
EXAMINER PARA, ANNETTE H				
ART UNIT 1661		PAPER NUMBER		
NOTIFICATION DATE 06/30/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@weyerhaeuser.com

### Office Action Summary

**Application No.**

10/636,081

**Applicant(s)**

GUPTA ET AL.

**Examiner**

Annette H. Para

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 15-19, 21, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-19, 21, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 03132008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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DETAILED ACTION

Status of the Claims

Claims 1-13, 15-19, 21, 23 and 24 are rejected. Claims 14, 20 and 22 are cancelled.

The Rejection of Claims 1-13, 15-18, 21, 23 and 24 under 35 U.S.C. § 112, First Paragraph (enablement) has been withdrawn in view of Applicant's argument.

Rejections - 35 U.S.C. 112 New Matter

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

New Matter

**Claims 1-13, 15- 19, 21, 23 and 24 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1 (c) applicants claim "incubating" the embryos.

The instant specification does not appear to provide support for incubating the embryos. On page 7 of the specification applicants teach that embryos can be cultured on a development medium for 9 to 14 weeks.

Incubating the embryos is not supported.

Thus, such phrases constitute **NEW MATTER**. In response to this rejection, Applicant is required to point to support for the phrases or to cancel the new matter.

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*Claim Rejections - 35 USC § 112, second paragraph*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-13, 15-19, 21, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 1 recites the limitation "the embryos", there is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-13, 15-19, 21, 23 and 24 are rejected under 35 U.S.C.102 (b)** as being clearly anticipated by Pullman et al. (US 5,294,549 published on March, 15 1994).

The claims are drawn to a method for producing conifer somatic embryos by cultivating pre-cotyledonary cells in a medium comprising nutrient wherein the osmolality is from 180 mM/Kg to 400 mM/Kg then transferring them to a medium comprising abscisic acid, gibberellin and activated charcoal as an absorbent for a period of .5 week to 5 weeks. And finally, transferring the pre-cotyledonary somatic embryos to a development medium for a period from 9 to 14 weeks to produce cotyledonary somatic embryos.

Pullman et al teach a method of cultivating conifer pro-cotyledonary somatic embryos in a maintenance medium comprising nutrients that sustain the embryos. The maintenance medium has an osmolality of

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170mM/Kg to about 240 mM/Kg (column 15, lines 1-3). The pro-cotyledonary are then transferred to a medium comprising gibberellin and/or abscisic acid at concentrations of 0.05 and 15 mg/L (col. 13, lines 40-60) and comprising also activated charcoal (col. 13, lines 50-54), for at least 3 weeks (col. 15, lines 23-26). This medium has a reduced osmotic level compared to the one of the maintenance medium, thus less than 170 mM/Kg (column 15, lines 13-14). Finally, the pro-cotyledonary embryos are transferred to a development medium wherein the osmolality is above about 400 mM/Kg (col. 15, line 60). Pullman et al. also teach the use of activated charcoal at a concentration of 2.5g/L (Table 2). Further Pullman et al. teach media with a pH of 5.7 (Table 1). Fifty percent and 75% of the embryos population taught by Pullman et al. is inherently at the same developmental stage, absent evidence to the contrary. Pullman et al. teach that this method can be used for many species including loblolly pine (col. 7, lines 50-60). Pullman et al. is silent in the time frame period claimed in step (c) and but since Pullman et al. follow the same steps than those claimed by the instant Application, the time frame characteristic of 9 to 14 weeks is enough for inherent anticipation, absent evidence to the contrary.

Comment

No Claims are allowed

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (571) 272-0982. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975. The fax number for the organization where the application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either the Private PAIR or the Public PAIR. Status information for unpublished applications is available through the Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Annette H Para/  
Primary Examiner